

REMARKS

Claims 1-18 and 22-83 remain pending in the application. Claims 1, 27-32, 50, 61, 63, 65, 67, and 79-80 have been amended to facilitate prosecution. Claim 21 has been cancelled without prejudice to refile. No new matter has been introduced by these Amendments.

In the Office Action, the pending claims have been rejected as allegedly being obvious and unpatentable under 35 U.S.C. § 103(a) based on a number of grounds. As set forth in detail below, Applicants respectfully submit that these rejections are in error and should be withdrawn.

A. Rejections in view of U.S. Patent No. 4,173,627 (hereinafter "Madrang")

The Office Action has rejected Claims 1-18, 21-32, 36-53, 57-59, 61-62 and 73-83 as allegedly being obvious and unpatentable over the disclosure of Madrang further in view of Japanese Patent Abstract JP 08187277 (hereinafter "the JP Patent Abstract").

As amended, independent claims 1 and 80 each recite a composition comprising, in part, at least 10% by weight methyl acetate and 20% to 55% by weight of an alkanol component comprising ethanol. To this end, in order to support a *prima facie* case of obviousness, the prior art must teach, or at least suggest, the claimed invention as a whole. Moreover, there must be adequate motivation and a reasonable expectation of success to undertake the modifications proposed in the rejection. For the reasons set forth below, Applicants respectfully submit that the instant rejection fails to at least teach or suggest this claimed combination of features set forth above.

Initially, the Office Action has acknowledged that Madrang fails to explicitly teach the claimed combination of ethanol and methyl acetate. However, notwithstanding this deficiency the Office turns to the disclosure of the JP Patent Abstract for its specific teaching of a composition comprising methyl acetate and ethanol. Notably absent from this rejection is the identification of a suggestion, teaching or motivation that would lead one of ordinary skill in the art to combine the

disclosures of Madrange and the JP Patent Abstract. To modify a prior art reference without evidence of such suggestion, teaching or motivation is an impermissible hindsight reconstruction and simply takes the inventor's own disclosure as a blueprint for piecing together the prior art in an effort to defeat patentability. See *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Simply put, the motivation to modify the teaching of a reference cannot come from the invention itself. See *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Applicants do not dispute the fact that JP Patent Abstract discloses a composition comprising ethanol and methyl acetate. However, the Office's proposed combination of Madrange in view of the JP Patent Abstract lacks the requisite motivation or suggestion that would lead one of skill in the art to make the proposed combination. In particular, the teaching of Madrange is directed to hair lacquer compositions having a reduced inflammability. In contrast, the JP Patent Abstract is directed to the use of methyl acetate as a masking agent to mask the allegedly irritating odor of an alcohol component. Significantly, the Office Action fails to identify the suggestion, teaching or motivation in Madrange that would suggest the desirability of masking the allegedly irritating odor of an alcohol. Likewise, the Office has similarly failed to identify the suggestion, teaching or motivation in the JP Patent Abstract that would suggest the desirability of reducing inflammability of a composition utilizing methyl acetate to mask the alleged irritating odor of an alcohol. The mere absence of such suggestion, teaching or motivation to make the proposed combination is itself evidence of an impermissible hindsight reconstruction that simply takes the inventor's own disclosure as a blueprint for piecing together the prior art in an effort to defeat patentability.

Moreover, even assuming *arguendo* that one of skill in the art would have combined the disclosures of Madrange and the JP Patent Abstract as proposed in the instant rejection, the resulting combination still fails to arrive at the composition recited in the instant claims. In particular, the Patent Abstract recites "the concentration of the masking agent capable of effectively exhibiting the action is 0.1-10 wt.%, more preferably 0.5-5 wt.% based on the alcohol." To that end, Applicants' independent Claims 1 and 80 recite a composition comprising 20 wt% to

55 wt% of an alkanol component. Thus, following the teachings of the JP Patent Abstract, the highest concentration of methyl acetate that could effectively be used would be 10 wt %, based upon the alkanol component, *e.g.* 10% of 20 wt% to 55 wt%. In other words, following the teaching of the JP Patent Abstract, the effective amount of methyl acetate would not exceed 5.5 wt% of the total composition. However, contrary to the teaching of the JP Patent Abstract, Applicants' Claims 1 and 80 further recite that the methyl acetate component is present in an amount of at least 10 wt.% of the composition. Moreover, there is no suggestion or motivation in JP 08187277 to utilize methyl acetate in an amount exceed 10 wt% based upon the ethanol component. In particular, paragraph [0010] of JP 08187277 states that the solvent effect of the lower alcohol component may be compromised if the amount of the masking agent exceeds 10 wt%.¹ Therefore, the teachings of JP 08187277 actually teach away from a composition that comprises a methyl acetate component in an amount exceeding 10 wt% based upon an alcohol component.

Still further, the Office Action explicitly acknowledges that it relies on the JP Patent Abstract for its specific teaching of methyl acetate in combination with ethanol. Therefore, the Office Action must view this specific teaching in the context of the reference as a whole. It is improper to pick and choose from any one reference only so much of it that will support a given position without addressing the full appreciation of what the reference would suggest to one of ordinary skill in the art. *In re Wesslau*, 353 F.2d 238, 240, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965). To that end, the JP Patent Abstract explicitly specifies the effective amount of methyl acetate that can be used with an alcohol. As set forth above, this specific amount is significantly less than the amount recited in the instant claims. To further suggest that the JP Patent Abstract would motivate one of skill in the art to use an amount of methyl acetate greater than the amount specified therein would constitute a selective reading of the Abstract that is not supportable when the reference is read as a whole. Therefore, for at least this reason, the Office Action's further reliance on the teaching of the JP Patent Abstract still fails to render Applicants' claimed invention obvious.

¹ An English language translation of JP 08187277 A is attached hereto as Exhibit "A." The English language translation of JP 08187277A is also being submitted concurrently in an information disclosure statement.

Still further, the Office Action has also rejected several additional dependent claims on a number of grounds. Specifically, Claims 33-35, 56, 60 and 63-72 have been rejected under 35 U.S.C. § 103 over Madrange in view of JP 08187277, in further view of Chaung. Also, Claims 54 and 55 have been rejected under 35 U.S.C. § 103 over Madrange in view of JP 08187277, in further view of Morawsky. While Applicants do not concede or agree with these rejections, Applicants need not address the substantive merits of these rejections in detail because the combined teaching of Madrange, further in view of JP 08187277, is insufficient to defeat the patentability of independent Claims 1 and 80 as discussed above. Accordingly, it is respectfully submitted that dependent Claims 33-35, 54-56, 60 and 63-72 are also allowable over the instant rejections. See *In re Fine*, 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.")

B. Rejections in view of U.S. Patent No. 4,243,548 (hereinafter "Heeb")

The Office has also rejected Claims 1-18, 21-23, 27-51, 56-57, 61-72 and 76-83 as allegedly being obvious and unpatentable over the disclosure of Heeb further in view of JP 08187277. To this end, the Office Action has again acknowledged that Heeb fails to explicitly teach the claimed combination of ethanol and methyl acetate and thus relies upon the disclosure of the JP Patent Abstract for its specific teaching of a composition comprising both methyl acetate and ethanol.

Once again, notably absent from the instant rejection is the identification of a suggestion, teaching or motivation that would lead one of ordinary skill in the art to combine the disclosures of Heeb and the JP Patent Abstract. In particular, the Office Action states the motivation to make the proposed combination is provided by the Abstract's teaching of the use of ethyl acetate or methyl acetate to mask the odor of lower alcohols. Again, Applicant does not dispute the fact that the JP Patent Abstract discloses a composition comprising ethanol and methyl acetate. However, the Office Action's proposed combination of Heeb in view of JP 08187277 lacks the requisite

motivation or suggestion that would lead one of skill in the art to combine the teachings of these references.

Heeb is generally directed to pressurized aerosol formulations comprising at least 50% non-combustible constituents. In contrast, the JP Patent Abstract is directed to masking the irritating odor of an alcohol component with an alkyl acetate. Significantly, the instant rejection fails to identify the suggestion, teaching or motivation in Heeb that would suggest the desirability of masking the allegedly irritating odor of alcohol. Likewise, the rejection similarly fails to identify the suggestion, teaching or motivation in the JP Patent Abstract that would suggest the desirability of providing reducing inflammability of a composition utilizing methyl acetate to mask the alleged irritating odor of an alcohol. Irrespective of whether or not the JP Abstract Discloses methyl acetate and ethanol in combination, the rejection must identify a suggestion or motivation to combine these two references. The absence of any evidence of such suggestion, teaching or motivation to make the proposed combination is itself evidence of an impermissible hindsight reconstruction that simply takes the inventor's own disclosure as a blueprint for piecing together the prior art in an effort to defeat patentability.

Moreover, even assuming *arguendo* that one of skill in the art would have combined the disclosures of Heeb and the JP Patent Abstract as proposed in the instant rejection, the resulting combination still fails to arrive at the composition recited in the instant claims. As described in detail above, the JP Patent Abstract recites "the concentration of the masking agent capable of effectively exhibiting the action is 0.1-10wt.%, more preferably 0.5-5wt.% based on the alcohol." To that end, Applicants' independent Claims 1 and 80 recite a composition comprising 20 wt% to 55 wt% of an alkanol component. Thus, following the teachings of the JP Patent Abstract, the highest concentration of methyl acetate that could effectively be used would be 10 wt %, based upon the alkanol component, *e.g.* 10% of the 20 wt% to 55 wt%. In other words, following the teaching of the JP Patent Abstract, an effective amount of methyl acetate would not exceed 5.5 wt% of the total composition weight. However, in contrast, Applicants' Claims 1 and 80 further recite that the methyl acetate component is present in an amount of at least 10 wt.% of the total

composition. Moreover, as detailed above, JP 08187277 actually teaches away from a composition that comprises a methyl acetate component in an amount as recited in the instant claims. Therefore, for at least this reason, the Office Action's further reliance on the teaching of the JP Patent Abstract again fails to render Applicants' claimed invention obvious.

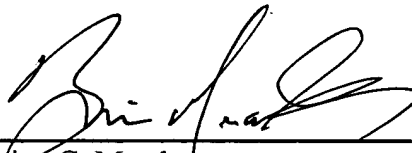
Furthermore, the Office Action has again explicitly acknowledged that it relies on the JP Patent Abstract for its specific teaching of a composition comprising methyl acetate and ethanol. Therefore, the Office Action must also view this specific teaching in the context of the reference as a whole. As discussed above, the JP Patent Abstract explicitly specifies the amount of methyl acetate that is effective for use in combination with an alcohol. Further, this specified amount is significantly less than the amount recited in the instant claims. Thus, to suggest that the teaching of the JP Patent Abstract would motivate one of skill in the art to use an amount of methyl acetate that exceeds that effective amount specified therein would again constitute a selective reading of the Abstract that is not supportable when the Abstract is read as a whole. Therefore, for at least this reason, the Office Action's reliance on the teaching of the JP still fails to render Applicants' claimed invention obvious.

CONCLUSION

In view of the Amendments and Remarks set out above, it is respectfully asserted that the rejections set forth in the Office Action of October 20, 2005 have been overcome and that the application is now in condition for allowance. Accordingly, Applicants respectfully seek notification of same.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

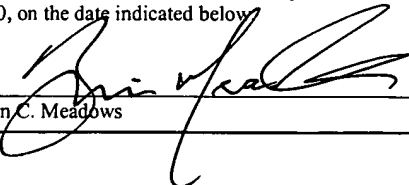


Brian C. Meadows
Registration No. 50,848

NEEDLE & ROSENBERG, P.C.
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)

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Brian C. Meadows

11-20-2006
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